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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,195	08/28/2000	Stephen J. Whitney	0112690-004	7963

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EXAMINER

LAXTON, GARY L

ART UNIT	PAPER NUMBER
2838	

DATE MAILED: 06/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/649,195	WHITNEY, STEPHEN J.	
	Examiner	Art Unit	
	Gary L. Laxton	2838	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 01 April 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-10, 13-27, 30 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,510,032. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6,510,032 discloses an integrated overcurrent and overvoltage apparatus for use in the protection of telecommunication circuits with a plurality of terminals for connecting the overcurrent and overvoltage portions of the integral circuit device to be protected.

The instant invention is merely an obvious variation of an invention claimed in the patent in that the main difference in the claimed invention is wherein a part of the overvoltage protection portion serves as one of the plurality of terminals. Furthermore, they are not patentably distinct from each other because in the above mentioned claims the applicant refers to a "mounting member" in the instant application as opposed to a "housing" as used in the conflicting application. The claimed phrases are interchangeable and not patentably distinct. Still furthermore, the mounting member which comprises a tube with first and second terminals disposed on the outer surface was previously claimed in the conflicting application, however, as stated above the previous application recited a "housing" instead of a "mount member"

In an integral device with a plurality of terminals connecting overcurrent and overvoltage portions; it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a part of the overvoltage protection portion as one of the plurality of terminals in order to make an electrical connection to the device to be protected so that the device would be protected from overvoltage.

4. Claims 11, 12, 28, 29 and 32-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,510,032 in view of U.S. Patent 6,377,435.

U.S. Patent No. 6,510,032 discloses an integrated overcurrent and overvoltage apparatus for protection of telecommunication circuits as stated above except for second and third overvoltage protection portions.

Nabell et al teaches the claimed circuit structure of second and third overvoltage protection portions. As observed in figure 1 there is illustrated a circuit for protection of communication lines comprising two overcurrent portions (fuses 105 and 106) as well as three overvoltage protection portions (device 109) as claimed including the ground connection (110). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the protection circuit of Nabell et al in place of the protection circuit of Curry in order to provide an improved circuit design that meets UL requirements and provides effective sneak current protection as taught by Nabell et al.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-10, 13, 15, 20, 23, 24, 26 and 30 are rejected under 35

U.S.C. 102(b) as being anticipated by Oguchi et al.

Claims 1, 3, 9, and 10. Integral circuit protection device (figure 16) with overcurrent and fuse (figure 15; 60 with fuse 56), overvoltage (28), plurality of terminals (66a-d), circuit to be protected (30), as shown in figures 15 and 16 a part of the overvoltage protection portion of 28 serves as one of the terminals (figure 15; A' and 28), and substrate 64.

Claims 2 and 8. Figure 2, first terminal A', second terminal A, third terminal 28a. overvoltage portion is also connected to terminal 2 through 28b and 22 and 23. Second and third terminal are on the same side. See figure 2.

Claim 5. The overcurrent is in series and the overvoltage is in parallel. See figure 15.

Claims 6 and 7. Figure 15, thermally conductive portion 13.

Claims 13, 15, 23, 24, 26 and 30. figure 15, overcurrent device (10) between first terminal (A) and second terminal (conductor connected from the node between 56 and 13 and circuit 30), mounting member 64, overvoltage device (28) connected to the second terminal through 13 and connected to a third terminal A'. terminal 28b serves as a part of the overvoltage voltage that is the third terminal. See for example figure 14 (28b and A'). Fuse figure 15 (56).

Claim 20. The overcurrent is in series and the overvoltage is in parallel. See figure 15.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oguchi et al in view of acknowledged prior art figure 1.

Oguchi et al disclose the claimed invention as stated above, claims 4 and 16 add the limitation wherein the overvoltage portion includes a bi-directional thyristor.

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The acknowledged prior art discloses on page 1 of the specification and in figure 1 that it is well known to use a bi-directional thyristor 110 in combinations with a fuse for protecting a communication circuit against overvoltage. It would have been obvious to a person having ordinary skill in the art at the time of the invention was made to modify the device of Oguchi et al and use a well known bi-directional thyristor for the overvoltage portion as taught by the acknowledged prior art since it is well known that such devices provide excellent overvoltage protection in communication circuits.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L. Laxton whose telephone number is (703) 305-7039. The examiner can normally be reached on Monday thru Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Sherry can be reached on (703)308-1680. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7724 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

GLL  
June 23, 2003

  
6/26/03  
MICHAEL SHERRY  
SUPERVISORY PATENT EXAMINER  
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